

## REMARKS

Claims 1-11 were pending in this Application as of the Office Action of May 14, 2010, with claims 4-9 having been previously withdrawn. Claim 1 is amended with this Response. Claim 2 is cancelled. The Examiner's and rejection will now be respectfully addressed.

### Rejections under 35 U.S.C. §103(a)

Claims 1-3 are rejected under 35 U.S.C. §103(a) as being obvious over United States Patent No.755,644 to Guild ("Guild" hereinafter) in view of United States Patent No. 5,475,910 to Yamamota ("Yamamota" hereinafter). Applicant respectfully traverses this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicant's claim 1 recites *inter alia*,

"manually applying a tool perpendicularly to a surface of the piece of metal and close to a periphery of each hole, an end of said tool having a tip for pushing back a lip of metal onto the girdle of the stone, said tool including a face with multiple facets that converge at said tip, and forming at least one indentation comprising at least one light-reflecting facet via said applying and a pressing of said multiple facets into said surface of the piece of metal."

Applicant first notes that the amendments made to the above quoted element find support at at least Figures 5, 6, and 8 of Applicant's disclosure.

Applicant next and respectfully notes that neither Guild nor Yamamoto, taken alone or in combination, teach formation of at least one indentation comprising at least one light-reflecting facet via a tool including a face with multiple facets. On the contrary, Guild teaches a tool with a

face that is merely conical “a” or inclusive of a depression “b,” and Yamamoto fails to remedy this deficiency of Guild (and is not used as such by the Examiner)

Furthermore, it is again respectfully noted that Guild is completely silent regarding indentation with light reflecting facets. Instead, and as mentioned previously, Guild repeatedly references formation of “burs” in the material *c*. Burs, by definition, are ragged edge raised on the surface of metal during drilling, shearing, punching, or engraving...or rough or irregular protuberances on any object (dictionary.com). This definition as provided by Applicant of a rough surface is in line with **applying heat to the material *c*** (as is taught in Guild at page 2, lines 20-23), in that application of heat to plastic will result in a rough, non-reflective surface at least at the points of heat application.

The Examiner’s provided definition of a “bur” as something that “sticks or clings” is 1) not as appropriate to the art as a definition directed to a “ragged edge raised on a surface of metal” (see Applicant’s definition as provided by dictionary.com), and 2) irrelevant to any enhancing of beauty or provision of a reflective surface in a piece of metal jewelry. On the contrary, Applicant respectfully asserts that there is absolutely no explicit or implicit connection between an object defined to “stick or cling” and a reflective surface created via an impression. In fact, a “bur” as defined by the Examiner (i.e. something that sticks or clings) would be better suited as a description of the jewels *d* of Guild (the jewels are the objects sticking or clinging) than the features (burs) *c* that hold the jewels in place (i.e. the burs as actually discussed in the reference).

For at least this reason, and contrary to the Examiner’s assertion at pages 2-4 of the Office Action, Guild fails to teach a light reflecting facet created by an indentation. Thus, since Yamamoto fails to remedy this deficiency of Guild (and is not used as such by the Examiner), Applicant respectfully asserts that the proposed combination of Guild and Yamamoto fails to teach every element of Applicant’s claims.

In addition, and contrary to the Examiner’s comments spanning pages 2 and 3, it is respectfully asserted that usage of a hammer or the like would be completely improper in the field of stone setting. In fact, mechanically applying the tool provides an advantage in that it allows for delicate and fine placement of a relatively small tool face between stones of relatively

small dimensions (please see the below Figure from Applicant's website, which demonstrates tool usage on scale). In this field, manual placement of the tool has the particular purpose of allowing a craftsman to make precise indentations at surfaces most pleasing to the eye. Accordingly, Applicant respectfully asserts that manual application is not an obvious design choice.

Furthermore, Applicant again respectfully notes that Guild discloses his "invention" to be "specifically intended" for use in plastic material (please see page 2, lines 18-23). Accordingly, Guild teaches against a combination/modification with the metal of Yamamoto (or any metal for that matter).

With still further reference to page 2, lines 18-23 of Guild, it is respectfully noted that Guild also discloses his "invention" to be "specifically intended" for material that may be softened by the application of heat. As metal will obviously not be softened via the same procedures as plastic (increased heat, different tools and precautions, etc.), a modification to Guild that results in a softening of metal (particularly hard metals such as the titanium recited in Applicant's new claim 11) will require a change in the principle operation of Guild, and be improper under MPEP 2143.01 VI. In addition, if Guild were modified such that metal softening techniques were applied to the plastic material *c*, the material would deform beyond recognition and be rendered inoperable. Such a modification would be improper under MPEP 2143.01 V.

Lastly, Applicant respectfully notes that the Guild reference is over 100 years old. This is important in that if, *pro arguendo*, Guild were to be improperly interpreted to have *tried* to create a smooth light reflecting surface in the material *c* (such an interpretation being necessary if one were to conclude that Guild teaches the light reflecting facet of Applicant's claims), it would certainly be concluded that Guild *failed* to do so (see the "bur" discussion above). Accordingly, a reference of Guild's age would be improper in an obviousness rejection because it would have "tried and failed to solve the problem." (Please see MPEP 2145 VIII, *In re Wright*, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977))

For at least the above reasons, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 1-3 with respect to the proposed combination of Guild and Yamamoto.

Claim 11 is rejected under 35 U.S.C. §103(a) as being obvious over Guild in view of Yamamota and United States Patent No. 6,668,584 to Tosti ("Tosti" hereinafter). Applicant respectfully traverses this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claim 11 depends from claim 1. As such, for at least the reasons discussed above, the proposed combination of Guild and Yamamota fails to teach every element of claim 11. In addition, since Tosti fails to remedy the deficiencies of the proposed combination of Guild and Yamamota, any proposed combination of Guild, Yamamota, and Tosti would also fail to teach every element of claim 11. For at least this reason, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claim 11 with respect to the proposed combination of Guild, Yamamota, and Tosti.

Conclusion

Applicant believes that all of the outstanding objections and rejections have been addressed herein and are now overcome. Entry and consideration hereof and issuance of a Notice of Allowance are respectfully requested.

Applicant hereby petitions for any extension of time under 37 C.F.R. 1.136(a) or 1.136(b) that may be necessary for entry and consideration of the present Reply.

If there are any charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

The Office is invited to contact applicant's attorneys at the below-listed telephone number concerning this Amendment or otherwise regarding the present application.

Respectfully submitted,

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Date: November 15, 2010